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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,071	01/19/2007	Catherine Rougeot	296415US0PCT	6477

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EXAMINER	
JIANG, DONG	
ART UNIT	**PAPER NUMBER**
1646	

NOTIFICATION DATE	DELIVERY MODE
07/08/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/593,071	ROUGEOT ET AL.	
	Examiner	Art Unit	
	DONG JIANG	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 June 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5-19,22-64 and 66* is/are pending in the application.

4a) Of the above claim(s) *10-14,17-19,22-64 and 66* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,6,15 and 16* is/are rejected.

7)☒ Claim(s) *5 and 7-9* is/are objected to.

8)☒ Claim(s) *1,3,5-19,22-64 and 66* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED OFFICE ACTION

The request filed on 02 June 2010 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/593,071 is acceptable, and a RCE has been established. An action on the RCE follows.

Applicant's amendment filed on 02 June 2010 is acknowledged and entered. Following the amendment, claims 4, 20 and 67 are canceled, and claims 1, 6, 15 and 16 are amended.

Currently, claims 1, 3, 5-19, 22-64 and 66 are pending, and claims 1, 3, 5-9 15 and 16 are under consideration. Claims 10-14, 17-19, 22-64 and 66 remain withdrawn from further consideration as being drawn to a non-elected invention.

Withdrawal of Objections and Rejections:

All objections and rejections of claims 4, 20 and 67 are moot as the applicant has canceled the claims.

The rejection of claims 1, 3 and 5-9 under 35 U.S.C. 112, second paragraph, as being indefinite is withdrawn in view of applicant's amendment.

The enablement rejection of claims 5 and 7-9 under 35 U.S.C. 112, first paragraph is withdrawn in view of applicant's amendment.

The lack of written description rejection of claims 1 and 3 under 35 U.S.C. 112, first paragraph are withdrawn in view of applicant's amendment.

The prior art rejection of claims 1, 3, 6, 15, and 16 under 35 U.S.C. 102(b) as being anticipated by Dickinson et al. (Curr Eye Res. 1996 Apr;15(4):377-86) is withdrawn in view of applicant's amendment.

Formal Matters:

Claims

Claims 15 and 16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 15 and 16, dependent from claim 1, recite "a pharmaceutical composition comprising a peptide according to claim 1 *or a mimetic peptide thereof*", which broadens the scope of the independent claim 1. As such, claims 15 and 16 fail to further limit the subject matter of a previous claim.

Rejections under 35 U.S.C. §112:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15 and 16 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for the reasons of record set forth in the previous Office Actions mailed on 8/5/09, and 2/4/10, and for the reasons below.

Applicants argument filed on 02 June 2010 has been fully considered, but is not deemed persuasive for the reasons below.

At page 20 of the response, the applicant argues that the amended claims 15 and 16 specify that the structural modification of the mimetic is added/made to "a peptide according to Claim 1." This argument is not persuasive because the recitation "replacement of one *or more* of the amino acids" reads on replacing all amino acids of the peptide of claim 1, thus, the claims encompass functional equivalents of the peptide of claim 1, which do not have to have sequence similarity to the peptide of claim 1. As such, it is unclear as to what molecules are encompassed by the claims. The metes and bounds of the claim, therefore, cannot be determined. The claims are further indefinite for the recitation "conformational restraints", "replacement of one *or more* amide bonds with non-amide bonds", and "protection of one *or more of the N-terminus, the C-*terminus" because it is unclear what they meant or encompass. For example, what bonds would

be used to replace all amide bonds, and what the peptide would become if all amide bonds are replaced? Also, how many N-terminus, or the C-terminus does a peptide have? The metes and bounds of the claims, therefore, cannot be determined.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

New Matter

Claim 1 and the dependent claims 3, 6, 15 and 16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have not pointed out, nor can the Examiner locate, the basis in the specification for the limitation "consists of *at most* 15 amino acids" in the newly added claims 16 and 18, respectively.

This is a new matter rejection.

Written Description

Claims 15 and 16 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record set forth in the previous Office Actions mailed on 8/5/09, and 2/4/10, and for the reasons below.

Applicants argument filed on 02 June 2010 has been fully considered, but is not deemed persuasive for the reasons below.

At pages 21-22 of the response, the applicant argues that the amended claims 15 and 16 specify that the structural modification of the mimetic is added/made to "a peptide according to Claim 1", thus, claims 15 and 16 are drawn to pharmaceutical compositions comprising the peptide according to Claim 1 or a mimetic thereof, accordingly, the structural modifications that are made to the mimetic peptide are defined in the claims. Applicants further argue that the

mimetic peptide is obtained through structural modification of the peptide of claim 1, and the structural modification is selected from a group of clearly defined chemical modifications, as such, the claimed peptide and mimetic peptides are fully described in full, clear, concise, and exact details so as to comply with the written description requirement of 35 U.S.C. §112. This argument is not persuasive because claims 15 and 16 recite "replacement of one *or more* of the amino acids", which reads on replacing all amino acids of the defined peptide of claim 1, thus, the claims encompass functional equivalents of the peptide of claim 1, which do not have to have sequence similarity to the peptide of claim 1. The specification provides no written description for such functional equivalent or mimetic peptide. Once again, the first paragraph of 35 U.S.C. § 112 "requires a 'written description of the invention' which is separate and distinct from the enablement requirement." The compound itself is required. "A description of what a material does, rather than of what it is, usually does not suffice." *Rochester,* 358 F.3d at 923; *Eli Lilly,* 119 at 1568. Instead, the "disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter purportedly described." *Id.*

Conclusion:

No claim is allowed.

Claims 5 and 7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Advisory Information:

Any inquiry concerning this communication should be directed to Examiner Dong Jiang whose telephone number is 571-272-0872. The examiner can normally be reached on Monday - Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol, can be reached on 571-272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dong Jiang/
Primary Examiner, Art Unit 1646
6/28/10